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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,610	10/16/2001	Richard D. Nelson	5683-00500 TER0009	5812
35617	7590	10/27/2003	EXAMINER	
CONLEY ROSE, P.C.			ANYA, IGWE U	
P.O. BOX 684908			ART UNIT	
AUSTIN, TX 78768			PAPER NUMBER	

2825
DATE MAILED: 10/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/981,610

Applicant(s)

NELSON, RICHARD D.

Examiner

Igwe U. Anya

Art Unit

2825

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8, 10, 12-16 and 18-35 is/are rejected.
- 7) ☒ Claim(s) 5, 9, 11, 17 and 36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 – 4, 6, 7, and 14 – 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Kanack (US Patent 5526172).
3. Kanack in fig. 4 teaches a MEMS comprising a metal beam (42, col. 12 line 36 - 49), suspended on both ends by insulating spacers (44), signals (102, 114) are passed from one end of the beam to the other a pair of electrodes beneath the beam (46a), and a contact structure (46b) between the electrodes, such that a bending force (100) contacts the beam with the contact structure which becomes an output (124) to signal.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8, 10, 12, 13, and 18 - 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanack (US Patent 5526172) in view of Goldsmith et al. (US Patent 5619061).

6. The Kanack reference teaches the features previously outlined, but lacks additional contact structures, the contact structure comprises a raised section on its upper surface, the contact structure has segments along a width of the beam, and an upper surface of the contact structure being level with the upper surfaces of the additional contact structures.

7. However, Goldsmith et al. teach multiple contact structures (1302, 1303), the upper surface of the contact structure being level with the upper surfaces of the additional contact structures (figs. 13b & 29h), and the contact structure comprises a raised section on its upper surface and has segments along a width of the beam (col. 8 lines 22 – 37).

8. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Goldsmith et al. into the Kanack reference to avoid a short circuit. Regarding the segmented contact structure being be at least three, where the general conditions of a claim are disclosed in prior art, discovering the optimum or working ranges involves only routine skill in the art. Furthermore, the recitation that an element is adapted to perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

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9. Claims 5, 9, 11, 17 and 36 are objected to as being dependent upon a rejected claim and would be allowable if rewritten in independent form.

Remarks

10. The examiner has reviewed applicant's comments and declaration of an earlier invention date. The rejection is withdrawn, however new references have been discovered that be used to reject some of the claims.

Contact Information


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igwe U. Anya whose telephone number is (703) 308-3549. The examiner can normally be reached on M - F 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Smith can be reached on (703) 308-1323. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

IA
October 19, 2003

Igwe U. Anya
Examiner
Art Unit 2825


MATTHEW SMITH
SUPERVISOR, PATENT EXAMINER
TECHNOLOGY CENTER 2800